UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,164	06/20/2003	Dah-Chih Lin	N1085-00098 [TSMC2002-128	7534

54657 7590 09/17/2008

DUANE MORRIS LLP (TSMC)
IP DEPARTMENT
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103-4196

EXAMINER	
ANTONIENKO, DEBRA L	

ART UNIT	PAPER NUMBER
3689	

MAIL DATE	DELIVERY MODE
09/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/601,164	LIN ET AL.	
	Examiner	Art Unit	
	DEBRA ANTONIENKO	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 June 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to independent Claims 1 and 11, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter. Claims 2-10 and 12-16 are dependent and are rejected in a like manner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-3, 5, 17, and 19** are rejected under 35 U.S.C. 102(b) as being anticipated by Newman, U.S. Patent Number 5,774,833 (hereinafter Newman).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Regarding Claims 1 and 17, Newman teaches a method (Abstract) and system (data store; computer operatively connected to data store; parsing program executable in the computer (column 1, lines 64-65; Figure 2)), respectively, of analyzing a claim in a patent or patent application, comprising: a. retrieving a patent claim which has been rendered into a format parsable by a computer program into a computer memory (column 3, line 46 – column 4, line 9; Figure 1); b. parsing the claim into a set of discrete elements (column 11, lines 22-67); c. categorizing each element in the set of elements according to a predetermined rule (column 11, 15-21); and d. storing a set of categorized elements in a data store (column 12, lines 43-45; Figure 2).

Regarding Claim 2, Newman further teaches parsing further comprises at least one of (i) semantic indexing, (ii) latent semantic indexing, (iii) rules based parsing, or (iv) free form parsing (column 14, lines 9-24; Figure 7).

Regarding Claims 3 and 19, Newman further teaches wherein parsing further comprises: identifying each keyword set in each element, the keyword set comprising at least one of (i) a noun, (ii) an adjective and a noun, (iii) a verb, or (iv) an adverb and a verb (column 11, lines 35-59).

Regarding Claim 5, Newman further teaches the stored set of categorized elements is stored an interrogatable database (column 4, lines 19-20).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 4, 6-9, and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Won et al., U.S. Patent Number 7,054,856 B2 (hereinafter Won).

Regarding Claim 4, Newman does not explicitly teach wherein: each keyword set further comprises a modifier to categorize the keyword set, the modifier comprising at least one of (i) a modifier identifying the keyword set as a necessary keyword set or (ii) a modifier identifying the keyword set as a non-necessary keyword set. However, Won discloses separating significant words from unnecessary words (column 2, lines 1-8). It

would have been obvious to one of ordinary skill in the art at the time of the invention to modify Newman's invention with that of Won's capability to separate significant words from unnecessary words in order to efficiently and effectively evaluate the patent.

Regarding Claim 6, Newman does not explicitly teach wherein the categorization attribute is at last one of (i) a necessary attribute, (ii) a non-necessary attribute, (iii) a useful attribute, (iv) a non-useful attribute, or (v) a correlation attribute. However, Won discloses removing useless characters (column 5, lines 1-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Newman's invention with that of Won's capability to remove useless characters in order to efficiently and effectively evaluate the patent.

Regarding Claim 7, Newman does not explicitly teach a predetermined number of keyword sets are logically paired with at least one other keyword set. However, Won discloses a matching module wherein certain words are matched with other words in the patent (column 5, line 49 – column 6, line 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Newman's invention with that of Won's capability to match or pair certain words or keywords in order to be able to evaluate the patent.

Regarding Claim 8, Newman does not explicitly teach categorizing further comprises correlating each element with at least one category in a database of categories.

However, Won discloses classification is performed with data matched with the current inside database (column 6, lines 1-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Newman's invention with that of Won's capability to categorize or classify the data in order to be able to evaluate the patent.

Regarding Claims 9 and 18, Newman does not explicitly teach assigning a rating weight to each categorized element. However, Won discloses calculating a weight value per word (column 5, lines 27-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Newman's invention with that of Won's capability to assign weighted values in order to have a basis for evaluating the patent.

6. **Claims 11-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barney et al., U.S. Patent Number 6,556,992 B1 (hereinafter Barney) in view of Newman.

Regarding Claim 11, Barney teaches a method of analyzing a patent against a portfolio of patents, comprising generating a rating of each claim of the predetermined set of claims of the selected patent using a predetermined weighting rule (column 25, lines 52-67; Figure 11). Barney does not explicitly teach initializing a portfolio of patents in an interrogatable format; selecting a patent from the portfolio of patents for analysis; and parsing each of a predetermined set of claims of the selected patent into a set of

elements. However, Newman discloses initializing a patent in an interrogatable format (column 3, line 46 – column 4, line 9; Figure 1); selecting a patent from the plurality of patents for analysis (column 2, lines 36-49); and parsing each of a predetermined set of claims of the selected patent into a set of elements (column 11, lines 22-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Barney's invention with that of Newman's capabilities to prepare or initialize the patents into the proper format for analysis and then to select one of interest to continue the analysis in order to be able to effectively evaluate the patent.

Regarding Claim 12, Barney further teaches the rating is generated according to a database of functions (column 11, lines 38-59; column 12, lines 36-39).

Regarding Claim 13, Barney further teaches using a predetermined rule to identify a best claim of the predetermined set of claims of the patent (column 25, lines 52-67; Figure 11).

Regarding Claim 14, Barney further teaches sorting the rated claims according to a rate sorting rule (column 25, lines 52-67; Figure 11).

Regarding Claim 15, Barney further teaches the rate sorting rule comprises at least one of (i) a sort based on a rating and on a number of elements present in each claim of the patent, (ii) a sort based on a rating and on a number of elements present in each claim

of the selected patent where the elements are further marked as necessary or non-necessary, or (iii) a sort based on a rating and on a number of elements present in each claim of the patent where the elements are further marked as useful or non-useful (column 12, lines 7-39; column 25, line 52 – column 26, line 40).

Regarding Claim 16, Barney teaches that the patents comprise issued patents and patent applications (column 11, lines 30-31).

7. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Davies et al., U.S. Patent Application Publication Number 2003/0172020 A1 (hereinafter Davies).

Regarding Claim 10, Newman does not explicitly teach filtering a claim based on the categorized elements, filtering further comprising logically marking only those categorized elements which meet a predetermined rule for the filtering. However, Davies discloses intellectual assets that can be filtered by using common criteria ([0127], Figure11).

8. **Claim 20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Barney.

Regarding Claim 20, Newman does not explicitly teach a database of language equivalents useful to correlate a keyword set in a first expression to a keyword set in a second expression. However, Barney discloses a database of language equivalents useful to correlate a keyword set in a first expression to a keyword set in a second expression (column 21, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Newman's invention with that of Barney's capability of matching or correlating synonyms in order to efficiently evaluate the patent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is (571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DA
/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689